

REMARKS/ARGUMENTS

Applicant has amended Claim 68, and added new claims 77-85. Support for the claim amendments and the new claims have support throughout the specification, including, but not limited to the following: Claim 68 on page 22, lines 1-23; and Claim 77 on page 6, lines 19-30 and page 8, lines 15-20. No new matter has been entered by the claim amendments and the new claims, and the Applicant respectfully requests entry of the claim amendments and the new claims accordingly. Applicant respectfully requests an Examiner interview to discuss the substance of this response at the Examiner's convenience

Claim Rejections under 35 U.S.C. §112

Claims 68-76

In the Office Action, the Patent Office rejected Claims 68-76 under §112, first paragraph, as failing to comply with the written description requirement. The Examiner states that "Claim 68 recites the limitation 'detection mechanism configured to *measure*', emphasis added, which is considered new matter." Further, the Examiner states that "Applicant's 'detection mechanism' appears to be imaging devices such as radiography, ultrasonography, magnetic resonance imaging, etc, which *detect* or *display* an image, however does [*sic*] not appear to measure parameters." The following amendment to Claim 68 is sufficient to overcome the §112 rejection. And the amended Claim 68 satisfies the requirements of §112, first paragraph. The Applicant respectfully requests the Examiner to withdraw the §112, first paragraph, rejection accordingly.

Claim Objection

In the Office Action, the Patent Office objected to Claim 70 for lack of a period. The following amendment to Claim 70 has overcome this objection. The Applicant respectfully requests the Examiner to withdraw the objection.

Claim Rejections under 35 U.S.C. §102

Claims 68-72 and 74

Santini, Jr. et al. do not disclose "at least one region of the plurality of structural elements being composed of a second material, the second material having a second transition temperature and a second transition coefficient higher than the first transition temperature and

the first transition coefficient allowing for a change in the geometry or conformation in the second diametric state upon application of at least one of an internal force and an external force to the in vivo sensor device, wherein the change in geometry or conformation changes the positioning of the structural elements relative to the geometry of the second material”, as to anticipate Claim 68. Since *Santini, Jr. et al.* fail to disclose each and every element specifically defined in Claim 68, the rejection of Claim 68 under §102(e) has been overcome and should be withdrawn. Moreover, Claims 69-72 and 74 depend from Claim 68. These claims are further believed allowable over *Santini, Jr. et al.* for the same reasons set forth with respect to their parent Claim 68 since each sets forth additional elements of Applicant’s device.

Claim Rejections under 35 U.S.C. §103

Claims 68-75

Burmeister and Wolinsky et al. do not teach or suggest “at least one region of the plurality of structural elements being composed of a second material, the second material having a second transition temperature and a second transition coefficient higher than the first transition temperature and the first transition coefficient allowing for a change in the geometry or conformation in the second diametric state upon application of at least one of an internal force and an external force to the in vivo sensor device, wherein the change in geometry or conformation changes the positioning of the structural elements relative to the geometry of the second material”, as to render Claim 68 unpatentable. Since *Burmeister and Wolinsky et al.* fail to disclose each and every element specifically defined in amended Claim 68, the rejection of Claim 68 under §103(a) has been overcome and should be withdrawn. Moreover, Claims 69-76 depend from amended Claim 68. These claims are further believed allowable over *Burmeister and Wolinsky et al.* for the same reasons set forth with respect to their parent Claim 68 since each sets forth additional elements of Applicant’s device.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and pass this application to issue. The Applicant respectfully requests a telephone conference to expedite the prosecution of the

application, the Examiner is invited to telephone the undersigned at the number provided below at the earliest convenience.

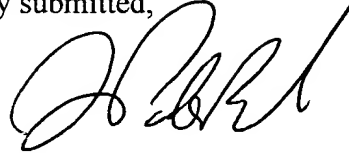
Any remarks in support of patentability of one claim should not be imputed to any claim, even if similar terminology is used. Additionally, any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertion regarding what the prior art shows or teaches, even if not expressly discussed herein. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Applicant submits payment of a one month extension fee. However, in the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the

filing of this document to Deposit Account No. 18-2000, of which the undersigned is an authorized signatory.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Paredes', written in a cursive style.

J. Peter Paredes
Reg. No. 57,364

June 22, 2009

ROSENBAUM & ASSOCIATES, P.C.
650 Dundee Road
Suite #380
Northbrook, IL 60062
Tel: (847) 770-6000
Fax: (847) 770-6006